

REMARKS

Upon entry of the present amendment, claims 4 and 5 will have been canceled and the features thereof will have been incorporated into claims 1 and 16. New claims 16-24 will have been submitted for consideration by the Examiner. In this regard, as noted above, claim 16 represents the features of claims 1 and 5 while claims 17-24 comprise the features of claims 2, 3 and 6-11, but depending from the newly submitted claim 16.

In view of the herein contained amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections together with an indication of the allowability of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

In rewriting these claims, Applicant has made various amendments to the language thereof to enhance the clarity thereof without in any way narrowing the scope thereof.

In view of the fact that the status of the present application is after Final Rejection, Applicant submits that entry of the present amendment is proper and in accordance with 37 C.F.R. § 1.116. In this regard, Applicant notes that claim 1 merely represents the combination of the features of claims 1 and 4 while claim 16 represents the combination of features of claims 1 and 5. Further, claims 17-24 represent features previously recited and considered by the Examiner in claims 2, 3 and 6-11. Accordingly, none of the newly submitted claims raise new issues requiring further consideration or search. Each of these limitations have already been considered by the Examiner in the outstanding Official Action.

Accordingly, Applicant respectfully submits that entry of the herein contained amendment is appropriate and proper and in accordance with 37 C.F.R. § 1.116.

Before discussing the merits of the outstanding Official Action, Applicant again notes that on October 9, 2003, an Information Disclosure Statement was filed in the present application. Together with the Information Disclosure Statement, a 1449 Form was attached and copies of the references were included. However, in neither the present outstanding Official Action nor in the previous Official Action of September 28, 2004 did the Examiner in any way indicate consideration of any of the references cited in the above-noted Information Disclosure Statement. Accordingly, Applicant respectfully requests the Examiner to consider and to confirm consideration of each of the properly cited references filed in the Information Disclosure Statement of October 9, 2003 by forwarding, in the next Official Action, a signed and initialed copy of the PTO-1449 Form that was attached to the above-noted Information Disclosure Statement.

Furthermore, should a copy of the Information Disclosure Statement and the references not be of record in the file of the U.S. Patent and Trademark Office, the Examiner is respectfully requested to contact the undersigned who will promptly provide a duplicate copy of the references and of the Information Disclosure Statement so that the file of the present application can be rendered complete. In addition, Applicant's undersigned representative will provide the Examiner with a mailroom date-stamped receipt evidencing the filing of the above-noted Information Disclosure Statement, PTO-1449 Form and the references cited therein in the U.S. Patent and Trademark Office on October 9, 2003, well before the issuance of any action on the merits in the present

application. Accordingly, consideration of the cited references is appropriate and is now respectfully requested.

Turning to the merits of the outstanding Official Action, claims 1-3 and 9-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by BLUM (U.S. Patent No. 5,219,497). Claims 4-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over BLUM and further in view of UMEDA (U.S. Patent No. 5,864,380). Applicant respectfully traverses each of the above-noted rejections and submits that they are inappropriate with respect to the combinations of features recited in Applicant's claims.

In the outstanding Official Action, the Examiner indicated claims 12-15 as allowable. Applicant notes the Examiner's indication with appreciation and obvious acquiescence but submits that all the claims in the present application are in condition for allowance and respectfully requests an indication to such effect.

Applicant's invention is directed to a multifocal spectacle lens having a front surface and a back surface. Each of the front and back surfaces is configured as one of a multifocal surface and a progressive power surface and distributions of surface power of the front surface and the back surface are different from each other. This combination of features as recited in claims 1 and 16 is not taught, disclosed nor rendered obvious by BLUM nor by the combination of BLUM and UMEDA.

Additionally, Applicant's independent claim 1 now recites that an average surface power of an upper area of the front surface is greater than an average surface power of a lower area of the front surface and an average surface power of a lower area of the back surface is greater than an average surface power of an upper area of the back

surface. This combination of features is clearly not taught, disclosed nor rendered obvious by any proper combination of BLUM and UMEDA.

Additionally, claim 16 recites that an average surface power of a lower area of the front surface is greater than an average surface power of an upper area of the front surface and an average surface power of an upper area of the back surface is greater than an average surface power of a lower area of the back surface. This combination of features is also not taught, disclosed nor rendered obvious by any proper combination of BLUM and UMEDA cited by the Examiner.

In setting forth the rejection of claim 1, the Examiner asserted that BLUM at column 5, lines 59-61, discloses the features thereof. Moreover, in addressing Applicant's remarks and arguments, the Examiner asserted that BLUM specifically discloses "that a multifocal or progressive region can be added to the front lens surface, the back lens surface or both. While this is correct, BLUM contains no disclosure whatsoever that distribution of surface power of the front surface and the back surface are different from each other. Without this essential recitation of each of Applicant's claims 1 and 16, BLUM is an inappropriate basis for the rejection thereof, particularly under 35 U.S.C. § 102. Accordingly, based on this distinction alone, claims 1 and 16 are clearly patentable over the combination of references cited by the Examiner.

Applicant notes that as a result of the combination of features defining Applicant's invention and particularly including the difference in distributions of surface powers on the front surface and on the back surface, it is possible to design the back surface to have, for example, an optimum progressive power based on or in response to the configuration of the front surface. In other words, as a result of the combination of the

recited features of the present invention, one can design the back surface to have optimum progressive power based on a power distribution of the front surface. Thus, the combination of front and back surfaces as defined in Applicant's claims 1 and 16, enables production of a lens having sufficient optical performance to cover the requirements of various specifications and prescriptions of a wide range of customers.

In this regard, Applicant notes the use of the term "customers" in Applicant's claims. By this term, Applicant does not necessarily mean paying customers or customers in any limited sense, rather the term "customers" is used in its broadest generic sense to refer to users or other persons or entities requiring particular spectacle prescriptions.

With reference to the portion of BLUM cited by the Examiner (i.e., column 5, lines 59-61), neither this portion of BLUM nor the remainder of the BLUM disclosure supports the Examiner's position that the distribution of surface powers of the front and back surfaces are different from each other. Column 5, lines 59-61 of BLUM merely states that a multifocal or progressive region can be added to the front lens surface, the back lens surface or to both surfaces. However, there is no disclosure or teaching in BLUM that when, e.g., a multifocal surface is added to one of the lens surfaces and a progressive region is added to the other of the lens surfaces, the distributions of refractive power are different from each other. BLUM is totally silent with regard to this explicitly recited feature of Applicant's invention and thus provides no teaching with respect to this feature. Accordingly, for this reason alone, Applicant's claims 1 and 16 are clearly patentable over BLUM.

Additional shortcomings and deficiencies of BLUM with respect to the limitations of Applicant's claims 1-3 and 9-11 are set forth in the Response filed on January 26, 2005 and in the interests of brevity and to avoid duplication, the Examiner is respectfully requested to review the discussion of the shortcomings and deficiencies in the above-noted Response.

As noted above, by the present Response, Applicant has incorporated the features of claim 4 into claim 1 and the features of claims 1 and 5 into new claim 16. With respect to previously pending claims 4 and 5, the Examiner relies on the teachings of UMEDA. However, UMEDA does not disclose the features recited in previous claims 4 and 5 or in presently pending claims 1 and 16.

In this regard, in addressing the recited features of Applicant's claims 4 and 5, the Examiner repeatedly refers to and relies on UMEDA, column 6, lines 60-67. However, neither this portion of the disclosure of UMEDA nor any other portion of the disclosure of UMEDA contains any teaching regarding these recited features of Applicant's invention.

Claims 1 and 16 further define the multifocal spectacle lens in terms of the relative magnitudes of the mean refractive powers of upper areas of the front surface with respect to the lower areas of the front surface as well as the relative magnitudes of the mean refractive powers of the lower areas of the back surface with respect to the upper area of the back surface.

It is respectfully submitted that no disclosure relevant to these limitations of claims 1 and 16 is contained in UMEDA. In particular, the portion of UMEDA to which the Examiner makes repeated reference contains no mention of an upper area or lower

area of either the front or the back surfaces of the lens disclosed therein. Rather, UMEDA discloses that the lens defined therein "also comprises an intermediate vision portion between the near vision portion and the specific distance vision portion". The intermediate vision portion is also defined to comprise a progressive zone from which there is a progressive change in refractive power of the lens from the near vision portion and the specific distance vision portion. The progressive zone is defined to generally have a length sufficient to minimize rotational fatigue while providing enhanced wearer comfort when the lens is worn for close range work. However, none of the intermediate portion or the progressive zone are disclosed to be in either an upper portion or a lower portion of a front or a back of the lens. Accordingly, UMEDA contains no disclosure regarding the relative magnitudes of the mean refractive powers for upper and lower areas of the front and rear surfaces as defined in claims 1 and 16.

For this additional reason, the combination of BLUM and UMEDA is inadequate and insufficient to render the claims of the present application unpatentable. Should the Examiner persist in his expressed position that UMEDA discloses the relationships between the relative average surface powers of the upper and lower areas of the front and rear surfaces as recited in claims 1 and 16, he is respectfully requested to indicate precisely where any mention is made of average surface power of an upper area and of a lower area of the front and rear surfaces of the lens disclosed therein.

Moreover, it is respectfully submitted that the Examiner has not set forth a proper basis for the combination of these references. In other words, the Examiner has provided no proper motivation for combining these references.

Applicant notes that BLUM and particularly the portion of BLUM upon which the Examiner relies and to which the Examiner directs Applicant's attention, deals with adding a progressive region to one or both of the surfaces of the lens. However, the progressive region is merely an addition to the overall surface of the lens. In direct contrast, UMEDA relates to a lens wherein the entire surface thereof is a progressive power lens. It is respectfully submitted that a lens such as that of BLUM which only has a small progressive power portion added thereto does not give rise to the rotational fatigue upon close range work that UMEDA is designed to avoid. Thus, the addition of the features of UMEDA thereto do not appear to be necessary and certainly do not appear to be motivated by the prior art as is required for a proper rejection under 35 U.S.C. § 103.

In other words, the Examiner has provided no evidence whatsoever that the combination of references proposed to be combined would in fact be effective in providing the asserted benefit. Accordingly, for this additional reason, the Examiner's proposed rejection is submitted to be inappropriate and Applicant's claims are submitted to be clearly patentable thereover.

As noted above, Applicant notes with appreciation the Examiner's indication that claims 12-15 are allowable. In this regard, Applicant notes the Examiner's Statement of Reasons for Indication of Allowable Subject Matter. In this regard, Applicant does not disagree with any of the features noted by the Examiner. However, Applicant notes that each of the claims in the present application is directed to a combination of features or aspects and that the patentability of each claim is also based on the particular totality of features or aspects recited therein. Accordingly, the reasons for allowance should not

P2355.A04

be limited to those features noted by the Examiner in his Statement of Reasons for Allowance.

As noted above, although the status of the present application is after Final Rejection, entry of the present amendment is submitted to be appropriate and proper, in accordance with the provisions of 37 C.F.R. § 1.116. Applicant further notes that various grammatical and idiomatic language changes have been made to the language of the claims to improve the clarity and form thereof. These changes do not impact the indicated allowability of claims 12-15 and also do not raise issues with regard to the other claims pending herein.

Accordingly, Applicant respectfully requests entry of the present amendment together with an indication of the allowability of all the claims pending herein.

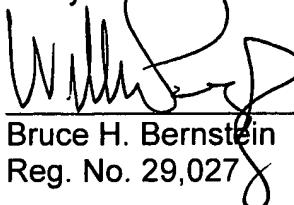
SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has discussed the various features of the claims and with respect to such features has pointed out the shortcomings of the references cited thereagainst. Applicant has further discussed the disclosure of the references and has pointed out the deficiencies thereof with respect to the features of Applicant's claims. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication to such effect in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Moriyasu SHIRAYANAGI



Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630

September 15, 2005
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191